

REMARKS

Claims 1-25 are pending in the present Application. Claims 17-23 and 25 have been withdrawn from consideration leaving Claims 1-6, 8-16 and 24 for consideration upon entry of the present Amendment. No claims have been amended or cancelled.

Election/Restrictions

In response to the Restriction Requirement dated September 6, 2005, Applicants elected to prosecute Claims 1-16 and 24. Accordingly, Claims 17-23 and 25 have been withdrawn from consideration. A statement to this effect was first made in the response submitted to the USPTO on March 15, 2006. The Examiner may inadvertently not have noticed this statement in the earlier response and hence the Applicants are restating it for his benefit.

Information Disclosure Statement

Applicants note that the Examiner has considered the art submitted in the Information Disclosure Statements filed 4/04, 1/05 and 8/05. Applicants have submitted a Supplemental Information Disclosure Statement to properly submit prior art that was not initialed by the Examiner because the month and year were not provided as required. Applicants respectfully request that the art submitted in this Supplemental Information Disclosure Statement be considered and a fully initialed PTO Form A820 be returned to the Applicants. Applicants have submitted a new Information Disclosure Statement with the lined out references properly listed with the month and the year.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-16 and 24 stand rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. Publication No. 2002/0183438 to Amarasekera et al. ("Amarasekera") in view of U.S. Publication No. 2005/0070657 to Elkovitch et al. ("Elkovitch") and U.S. Patent No. 5,591,382 to Nahass et al. ("Nahass"). (Office Action dated 06/06/06, page 2) Applicants respectfully traverse this rejection.

To establish *prima facie* obviousness the Examiner must first show that all elements of the claims are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The present application is directed to a conductive composition comprising an organic polymer; a nanosized conductive filler and/or carbon fibers having an average diameter of greater than or equal to about 1000 nanometers; and graphite, wherein the graphite has average particle sizes of about 1 to about 5,000 micrometers. (see Claim 1)

It is first submitted that Amarasekera was published less than a year before the filing of the present application and is therefore not a reference under 35 U.S.C. § 102(b), but would be available as a reference under 35 U.S.C. § 102(e). The present application was filed on 30th September 2003, while the Amarasekera reference was published on December 5, 2003. Since the reference applies as a 35 U.S.C. § 102(e) reference, the obviousness rejection should have been made under 35 U.S.C. § 103 (c) and not 35 U.S.C. § 103 (a).

Applicants also respectfully submit that Amarasekera is unavailable as prior art. 35 U.S.C. § 103(c)(1) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Both the present application and Amarasekera are under obligation of assignment to the General Electric Company. For these reasons, Applicants submit that Amarasekera cannot be relied on as prior art for the § 103(a) rejection.

In addition, Elkovitch also cannot be used as a reference under 35 U.S.C. § 103 (c). Elkovitch was filed on September 29, 2003, which is one day before the filing date of the present application, September 30, 2003. Elkovitch was published on March 31, 2005, about 18 months after the filing date of the present application and is therefore not available under 35 U.S.C. § 102(b). Therefore, Elkovitch is available as prior art only under § 102(e). Both, the present application and Elkovitch are also under obligation of assignment to the General Electric Company. For these reasons, Applicants submit that Elkovitch also cannot be relied on as prior art for the § 103(a) rejection.

Since Amarasekera and Elkovitch cannot be used as prior art, this leaves behind only Nahass from the original rejection. Nahass is directed to a polymeric composition having

improved toughness and conductivity comprising carbon fibrils, at least a portion of which are in the form of aggregates, wherein, as measured on an area basis, substantially all of the aggregates are less than about 35 micrometers in diameter. (Abstract) The Examiner has stated that Nahass teaches that it is common to form carbon fibers from polyacrylonitrile or pitch. (Office Action dated June 6, 2006 at page 4). The carbon fibrils of Nahass however are not carbon fibers formed from either polyacrylonitrile or pitch. They are not similar to the graphite described and claimed in the present invention. The carbon fibrils of Nahass are vapor grown carbon fibers, which are substantially different from the graphite particles currently claimed. The carbon fibrils of Nahass have a diameter between 3.5 and 75 nanometers and are tubular in shape. (see Col. 2, lines 9 – 11) The claimed graphite on the other hand has an average particle size of about 1 to about 5000 micrometers and is crystal vein graphite (CVG), which is in the form of flakes.

Thus, while Nahass does mention carbon fibrils and carbon fibers from polyacrylonitrile or pitch, Nahass does not teach a composition that comprises graphite particles. Nahass therefore does not teach a combination of a polymer with nanosized conductive fillers and/or carbon fibers and graphite as presently claimed. Thus Nahass does not teach all elements of the claimed invention and cannot render the claimed invention obvious. In addition since Nahass does not teach all elements of the claimed invention, there is no motivation to modify Nahass.

Thus, in summary, since Amarasekera and Elkovitch cannot be used as prior art and since Nahass does not teach all elements of the claimed invention, Applicants believe that the Examiner has not made a prima facie case of obviousness over Amarasekera in view of Elkovitch and Nahass. For these reasons at least, the Applicants respectfully request a withdrawal of the rejection and an allowance of the claimed invention.

Provisional Double Patenting Rejections

Claims 1-16 and 24 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-40 of U.S. Publication No. 2005/0070657 to Elkovitch. Claims 1-16 and 24 also stand rejected as being directed to the same invention over Claims 1-40 of Elkovitch. It is unclear whether the Examiner is making a statutory double patenting rejection under 35 U.S.C. § 101 in addition to the nonstatutory double patenting rejection. (Office Action dated June 6, 2006 at page 5, ¶¶ 6, 7).

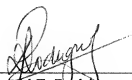
Applicants thank the Examiner for pointing out the potential double patenting issue between the claims of the present application and those of Elkovitch. In view of the possibility that claims in the cited application or the present application will be further amended before allowance, Applicants will defer responding to these provisional rejections until claims in the reference application are allowed, claims in the present application are otherwise allowable, and it is determined whether these provisional rejections become actual rejections.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No.50-1131.

Respectfully submitted,

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